REMARKS/ARGUMENTS

1.)   Examiner's Response to Applicants' Prior Arguments

The Applicants thank the Examiner for accepting Applicants' previously submitted arguments, and recognizing the failure of U.S. Patent No. 5,557,658, issued to Gregorek, et al. ("Gregorek) to anticipate claims 1-4, 6-7, 13-16 and 18-19. The Applicants further thank the Examiner for recognizing that claims 5 and 17 are not obvious over Gregorek in view of Rogers, et al. (US 5,946,386); claims 9, 10, 21 and 22 are not obvious over Gregorek in view of Bull, et al. (US 6,498,841); claims 11 and 23 are not obvious over Gregorek in view of Tatchell, et al. (US 6,160,877); and claims 12 and 24 are not obvious over Gregorek in view of Tatchell and Zhakov, et al. (US Pub. No. 2003/0021264).

2.)   Claim Rejections – 35 U.S.C. § 103(a)

In the present Office Action, the Examiner rejected claims 1-4, 6, 7, 9, 10, 13-16, 18, 19, 21, 22, 32 and 33 as being unpatentable over Gregorek in view of Casellini (US 6,404,860); claims 5, 17 and 29 as being unpatentable over Gregorek in view of Casellini and further in view of Rogers; claims 11, 23 and 24 as being unpatentable over Gregorek in view of Casellini and further in view of Tatchell; and claims 12, 24 and 35 as being unpatentable over Gregorek in view of Casellini and Tatchell and further in view of Zhakov. The Applicants, again, traverse the rejections.

In previous rejections, the Examiner rejected each of Applicants' independent claims as being anticipated by Gregorek. In accepting Applicants' response to the prior Office Action, the Examiner has recognized the deficiency of Gregorek in anticipating those claims. To overcome the deficiencies of Gregorek, the Examiner now looks to the teachings of Casellini. The teachings of Casellini in combination with Gregorek, however, also fail to teach the claimed invention.

Claim 1 recites:

> 1.   A method of controlling communications with at least two calling party devices by a user of a called party device, said method comprising the steps of:

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establishing a first call link between said called party device and a first calling party device;

receiving a call request to said called party device from a second calling party device;

placing said first call link on hold;

accepting said call request from said second calling party device to establish a second call link between said called party device and said second calling party device;

causing, through the selective activation by said user of said called party device, a message to be transmitted to said first calling party device, said step of causing a message to be transmitted to said first calling party device comprising the step of said user selecting one of a plurality of predefined messages using an input mechanism associated with said called party device while said called party device is in communication with said second calling party device, whereby said user of said called party device can communicate information to a user of said first calling party device without interrupting communications with a user of said second calling party device. (emphasis added)

The Applicants' invention is characterized by a user of a called party device causing a message to be transmitted to said first calling party device by selecting one of a plurality of predefined messages using an input mechanism associated with said called party device while said called party device is in communication with said second calling party device.

Gregorek discloses a call processing system which can transmit a generally continuous pre-recorded announcement to a telephony device that has been placed on hold. Unlike the Applicants' invention, however, the transmission of the pre-recorded announcement is under the automatic control of a switch 22 or attached network signaling system (ANSS) 23, rather than the user of a called party device. The Examiner fails to point to any teaching in Gregorek where a user of a called party device causes the sending of a message to a first calling party device using an input mechanism associated with said called party device.

Furthermore, and most importantly, claim 1 recites that the step of causing a message to be transmitted to a first calling party device (while on hold) includes the step of the user (of the called party device) selecting one of a plurality of predefined messages (using an input mechanism associated with said called party

device) <u>while the called party device is in communication with a second calling</u> <u>party device.</u> Gregorek simply does not disclose the ability of a user of a telephony device, <u>while a first calling party is on hold and such device is in communication</u> <u>with a second calling party,</u> to select one of a plurality of predefined messages and cause it to be transmitted to the first calling party, whereby the user of the called party device can communicate information to a user of the first calling party device without interrupting communications with a user of the second calling party device.

The Examiner states (page 3, 3rd paragraph, of the present Office Action) that Gregorek teaches:

> "the step of causing an announcement to the first calling party device comprising one of a plurality of customized announcements (i.e., predefined messages) using an input mechanism associated with the called party device while the called party is in communication with the second calling party." (emphasis added)

That assertion by the Examiner as to what Gregorek teaches, however, appears to contradict his later statement (page 3, 4th paragraph) that Gregorek "<u>does not</u> <u>specifically teach</u> 'the step of causing an announcement to the first calling party device comprising the step of the user selecting one of a plurality of predefined messages'." (emphasis added) Regardless of the Examiner's apparently contradictory statements, it is apparent that neither Gregorek or Casellini disclose the step of causing a message to be transmitted to a <u>first</u> calling party device **(while on hold)** includes the step of the user (of the called party device) selecting one of a plurality of predefined messages (using an input mechanism associated with said called party device) **while the called** **party device is in communication with a <u>second</u> calling party device.** The Examiner, again, ignores these limitations of claim 1 and points to no teaching in Gregorek or Casellini to support his rejection.

Furthermore, the Examiner points to no teaching or suggestion in Gregorek or Casellini to combine their teachings to arrive at the claimed invention. Moreover, <u>Casellini actually teaches away from the claimed invention</u>. The teachings of Casellini are directed to a Call Management Application <u>that is separate</u> from a user's device on which calls are received; the call management application is internet-based,

while a user actually receives calls on a separate telephony device. According to Casellini, a user has a telephone or other communication device, such as a mobile wireless handset (200). (see column 1, lines 41-43) If a user doesn't answer a call to their telephony device (analogous to Applicants' claimed "called party device"), then the call is redirected to a call management application that the user can access via their separate internet-connected computer. (see column 1, 45-51). It is to improvements in such call management application that the teachings of Casellini are directed. In contrast, as recited in Applicants' claim 1, **a user's called party device is used both to establish call links with different first and second callers**, but also to cause, through the selective activation by a user of the called party device, a message to be transmitted to a first calling party device, the step of causing a message to be transmitted to the first calling party device comprising the step of the user selecting one of a plurality of predefined messages **using an input mechanism associated with the called party device** while the called party device is in communication with the second calling party device, whereby a user of the called party device can communicate information to a user of the first calling party device without interrupting communications with a user of the second calling party device. **Casellini teaches away from the use of a common device for both call connections and simultaneous messaging to calling parties in the manner claimed by Applicants**. Accordingly, Casellini fails to overcome the deficiencies of Gregorek, and claim 1 is not obvious in view of those references.

Independent claims 13 and 25 recite limitations analogous to those of claim 1 and, therefore, those claims are also not obvious over Gregorek in view of Casellini. Furthermore, whereas claims 2-7 and 9-12 are dependent from claim , claims 14-19 and 21-24 are dependent from claim 13, and claims 26-35 are dependent from claim 25, and include the limitations of their respective base claims, those claims are also not obvious over Gregorek in view of Casellini, or in further view of Rogers, Tatchell, or Zhakov. **The Applicants, therefore, respectfully request that the Examiner withdraw the rejection of claims 1-7, 9-19 and 21-35 as being obvious.**
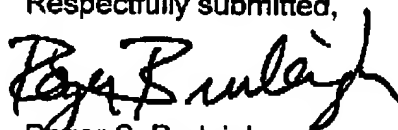
CONCLUSION

In view of the foregoing remarks, the Applicants believe all of the claims currently pending in the Application to be in a condition for allowance. The Applicants, therefore, respectfully request that the Examiner withdraw all rejections and issue a Notice of Allowance for Claims 1-7, 9-19 and 21-35.

The Applicants request a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,

Roger S. Burleigh
Registration No. 40,542

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Ericsson Inc.
6300 Legacy Drive, M/S EVR 1-C-11
Plano, Texas 75024

(972) 583-5799
roger.burleigh@ericsson.com